June 11, 2001, acknowledged that fees were paid for 22 claims. Nevertheless, the Action states that claims 1-59 are pending and subject to a Restriction Requirement under 35 U.S.C. § 121.

Applicants respectfully request that the previous direction to cancel claims 1-12 and 35-59 be made of record. Accordingly, claims 13-34 are pending.

Election

The Office Action alleges that claims 13-34 are directed to four patentably distinct inventions, set forth as Groups IV-VII of the Action.

Applicants thank Examiner Ungar for her time and courtesy in clarifying the restriction requirement in an interview held with Applicants' representative on May 24, 2002. In that interview, Applicants' representative pointed out that the specification uses the term *"in vivo"* in the context of cell-based screening assays such as yeast two-hybrid assays (see page 10, lines 16-26; page 11, lines 20-27; and page 25, lines 6-8). However, from the grouping of the claims in the Action (Groups IV-VII), and the discussion with the Examiner, it appeared that such cell-based assays are not considered by the Office to be *"in vivo"* assays.

In view of this difference in position, it was agreed in the interview that Applicants would elect, with traverse, claims 13-34 insofar as these claims are directed to a method of

identifying an effective agent that alters the association of a CAP with a second molecule, wherein the contacting takes place in a cell, and wherein the altered association is a decreased association.

Applicants further elect, with traverse, a species of generic claims 13 and 28 wherein the second molecule is CD40, wherein the cell is a yeast cell, and wherein the agent is a drug. Claims 13-15, 19-22, 24, 25, 28-30 and 34 read, at least in part, on the elected species.

Traversal of Restriction and Election Requirement

Applicants respectfully traverse the requirement for restriction between Groups IV-VII, which together encompass claims 13-34, and also the requirement for election of species within these Groups.

As set forth in MPEP § 803, for a proper restriction:

> (A) The inventions must be independent or distinct as claimed; and
> (B) There must be a serious burden on the examiner if restriction is not required.

Thus, it is not sufficient for an Examiner to assert that patentably distinct inventions are present in order to restrict an application or require an election of species. There must

also be a serious burden on the Examiner to search and examine the application if restriction or election is not required.

Applicants submit that search and examination of claims 13-34 as a whole does not pose a serious burden on the Examiner. This position was taken by the Office in issuing a restriction requirement in the parent application, Serial No. 08/349,357. In that Action, claims 13-34 were grouped together, and no election of species requirement was made (see Action mailed March 28, 1996).

Applicants note that all subject matter within Groups IV-VII is classified in the same class and subclass. Thus, search of these four Groups, and all disclosed species within these Groups, is contiguous. In other words, whether the assay is performed *in vitro* or *in vivo*, whether the association between CAP and a second molecule increases or decreases, whether the second molecule is CD40 or another molecule, whether cells used are yeast or mammalian, and whether the effective agent is a drug or a peptide, does not control classification. Since the invention is searched in the same class and subclass regardless of these aspects of the assay, it is respectfully submitted that there would be no serious burden on the Office to search and examine claims 13-34 as a whole.

CONCLUSION

Should the Examiner have any questions, she is invited to call Cathryn Campbell or the undersigned agent.

Respectfully submitted,

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